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THE LAW OFFICES OF ROBERT J. EICHELBURG
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EXAMINER

TOOMER, CEPHIA D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD LEVY

Appeal 2009-000443
Application 09/357957
Technology Center 1700

Decided: November 30, 2009

Before CHUNG K. PAK, CHARLES F. WARREN, and
PETER F. KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals to the Board from the decision of the Primary Examiner finally rejecting claims 29-32, 34-38, 41-43, 48, 49, 53, 55, 56, 58, 60-62, 64, 66-68, 72-85, 93, and 95-97 in the Office Action mailed April 11, 2006. In the Answer, the Examiner allowed claims 30, 55, 61, 64, 66, 75, 76, and 80-84, and objected to claims 43, 56, 58, 60, 62, 67, 74, and 77-79 as dependent on a rejected base claim. Ans. 2, 4, and 5. Claims 29, 31, 32,

34-38, 41, 42, 48, 49, 53, 68, 72, 73, 85, 93, and 95-97 remain for consideration on appeal. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2007).

We reverse the decision of the Primary Examiner.

Claim 29 illustrates Appellant's invention of a lubricating composition, and is representative of the claims on appeal:

29. A lubricating composition of matter comprising a polymer, where said polymer comprises a superabsorbent polymer that absorbs greater than about 100 times its weight in water combined with a material for lubricating a surface wherein said material for lubricating a surface comprises:

(1) a lubricating metal and alloy thereof, lubricating metal chalcogenide, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant;

or

(2) a silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene, or phthalocyanine compound;

(3) said material for lubricating a surface optionally containing a lubricant comprising an organic lubricant, inorganic lubricant, or a lubricant additive; or

(4) or a mixture thereof.

The Examiner relies upon the evidence in these references:

Obayashi	4,340,706	Jul. 20, 1982
Johnson	5,275,760	Jan, 4, 1994
Takayama	5,792,717	Aug. 11, 1998

Appellant requests review of the following grounds of rejection advanced on appeal by the Examiner (App. Br. ¹10-11):

¹ We considered the Appeal Brief filed September 24, 2007, the Examiner's Answer mailed December 14, 2007, and the Reply Brief filed February 14, 2008.

claims 29, 31, 32, 68, 72, 73, 85, 93, and 95-97 under 35 U.S.C. § 102(b) over Takayama (Ans. 4); and

claims 29, 34-38, 41, 42, 48, 49, and 53, under 35 U.S.C. § 103(a) over Johnson in view of Obayashi (Ans. 5).²

Opinion

The dispositive issue in this appeal is the interpretation to be made of the language “wherein said material for lubricating a surface comprises: (1) . . . a lubricating metal . . . carbonate, . . . or a particulate lubricating metal nitride . . .” in representative independent claim 29. In considering the issue, we interpreted the subject language of claim 29 by giving the terms thereof the broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the Specification unless another meaning is intended by Appellant as established therein, and without reading into the claim any disclosed limitation or particular embodiment. *See, e.g., In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004), and cases cited therein; *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

The plain language of claim 29 specifies a lubricating composition comprising at least the superabsorbent polymer combined with a material for lubricating a surface which comprises at least a lubricating material which must be selected from group (1) and/or group (2). With respect to the

² The Examiner has withdrawn the following grounds of rejection: claims “29, 30, 31, 68, 72-79, 83 and their dependents” under 35 U.S.C. § 112, first paragraph, written description requirement; and claims 29, 31, 35, 53, 55, 56, 61, 68, 72, 85, 93, and 95-97 over Martineu. Ans. 3.

ground of rejection over Takayama under § 102(b), the Examiner contends that when the language “a particulate lubricating metal nitride” in group (1) is given its broadest reasonable interpretation, Takayama’s porous ceramic material, the pores of which are filled with a high water absorbing resin, meets this limitation of claim 29. Ans. 4 and 6-7, citing Takayama, e.g., col. 3, ll. 59-62, col. 4, ll. 4-11, 30-32, and 60-62. We find Takayama further teaches “[t]he ceramic powders are shaped by conventional techniques . . . [and] then sintered.” Takayama, e.g., col. 4, ll. 11-21. In the Examiner’s view, Takayama forms the ceramic material from “particulate boron nitride,” and the “claims do not exclude forming a ceramic body from the particulate boron nitride” and “do not set forth that the lubricant composition is a ‘particulate’ lubricant composition.” Ans. 6-7.

We agree with Appellant that the subject language “a particulate lubricating metal nitride” plainly specifies that a particulate lubricating metal nitride material, which can be boron nitride, is a member of the groupings of lubricating materials at least one of which must be present in the lubricating composition along with the superabsorbent polymer. App. Br. 19; Reply Br. 5; *see* claim 32. Indeed, the open-ended term “comprising” opens claim 29 to include lubricating compositions which contain ceramic materials, but only in addition to materials in groups (1) and/or (2) required to be present in the composition. *See, e.g., Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555 (Fed. Cir. 1995) (“The claimed composition is defined as comprising - meaning containing at least - five specific ingredients.”); *In re Baxter*, 656 F.2d 679, 686 (CCPA 1981) (“As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the

term ‘comprises’ permits the *inclusion* of other steps, elements, or materials.”).

On this record, the Examiner has not established that particulate boron nitride is present in the compositions of Takayama. Thus, we reverse the ground of rejection of claims 29, 31, 32, 68, 72, 73, 85, 93, and 95-97 under 35 U.S.C. § 102(b) over Takayama.

With respect to the ground of rejection over Johnson and Obayashi under § 103(a), the Examiner contends that Johnson’s “alkali or alkaline earth metal carbonate” falls within the claim language in the subject phrase “a lubricating metal . . . carbonate” of group (1). Ans. 5 and 8, citing Johnson, e.g., col. 4, ll. 44-48. Appellant contends that “Johnson does not acknowledge carbonates as lubricating materials.” Reply Br. 5-6.

We agree with Appellant. The broadest reasonable interpretation of the subject phrase “a lubricating metal . . . carbonate” is any metal carbonate which acts as a material for lubricating a surface. Appellant discloses and claims lead carbonate as an example of surface lubricating metal carbonate. Spec. 16:19-21, and 24:23-24; *see* claim 32. The Examiner has adduced no evidence or scientific reasoning establishing alkali or alkaline earth metal carbonates as a surface lubricating material falling within claim 29.

Accordingly, we reverse the ground of rejection of claims 29, 34-38, 41, 42, 48, 49, and 53, under 35 U.S.C. § 103(a) over Johnson in view of Obayashi.

The Primary Examiner’s decision is reversed.

Appeal 2009-000443
Application 09/357957

REVERSED

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